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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,489	04/06/2001	Jarmo Makela	297-006914-US (C01)	5743
2512	7590	10/08/2003	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			HOOSAIN, ALLAN	
			ART UNIT	PAPER NUMBER
			2645	
DATE MAILED: 10/08/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/827,489

Applicant(s)

MAKELA ET AL.

Examiner

Allan Hoosain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-17, 20, 23-26, 28-30, 32-34, 36-38 and 40 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 18, 19, 21, 22, 27, 31, 35 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### **Withdrawal of Finality of the last Office Action**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. A new ground of rejection is given below.

### ***Allowable Subject Matter***

2. Claims 10-11 and 18-19, 21-22,27,31,35,39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Objections***

3. Claims 2,21-22,26,30,34,38 is objected to because of the following informalities: They recite the acronym "SMS". This acronym should be spelled out. Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16-17 recites the limitation "the clock" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,4-9, 12-13,15-21 and 23-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Mizikovsky** (US 5,327,486).

As to Claims 1,20,23-25,29,33 and 37, with respect to Figures 1-2 and 5, **Mizikovsky** teaches a method for replying to a call coming to a portable terminal wherein, in response to the incoming call,

the portable terminal identifies the caller on the basis of caller ID (an identification information), or

directs the incoming call to voice mail (another answering service),

said reply having a form selectable from accessories (a plurality of forms of communication), and

wherein said step of identifying the caller is accomplished by said portable terminal, and said step of sending a reply is accomplished by said portable terminal, said portable terminal being capable of performing said step of sending a reply by providing a selected response to said caller exclusively through the action of said portable terminal (Figure 1, label 50, Figure 2, label 114 and Figure 5, label 516).

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As to Claim 7, **Mizikovsky** teaches a method in accordance with claim 1, wherein said reply is at least partly formulated based on the identification of the calling party (Figure 5, label 506).

As to Claim 8, **Mizikovsky** teaches a method in accordance with claim 7 wherein a reply is sent to certain identified calling parties only (Figure 5, labels 508,512).

As to Claim 9, **Mizikovsky** teaches a method in accordance with claim 7, wherein the reply to be sent in response to the incoming call is different according to the respective company said call is coming from (Figure 5, labels 508,512,516).

As to Claims 12-13, **Mizikovsky** teaches a method in accordance with claim 7, wherein said identification of the calling party is based on registered caller IDs (a telephone notebook) comprised by the communication (Figure 2, label 106).

As to Claims 26,30,34,38, **Mizikovsky** teaches a portable terminal in accordance with claim 25, wherein said step of taking response action comprises sending a reply to the caller, said reply being a voice message (one of the following: a voice message, e-mail message, facsimile, and an SMS message in the form of a character string) (Col. 8, lines 51-59).

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*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Jambhekar et al.** (US 5,848,356).

As to Claims 2,6, **Mizikovsky** teaches a method in accordance with Claim 1, wherein the portable terminal sends said reply immediately in response to an incoming call, and said plurality of forms of communication include a voice message:

**Mizikovsky** does not teach the following limitation:

“an e-mail message, a facsimile message, and an SMS message in the form of a character string”

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However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches other accessory responses illustrated as peripherals could be used (Col. 7, lines 6-12). In particular, **Mizikovsky** teaches a facsimile peripheral which suggests a facsimile accessory and facsimile message; a multimedia terminal which suggests an e-mail accessory and response; EIA/T1A IS-54 alert messages which suggests a SMS accessory and response. **Jambhekar** teaches e-mail, facsimile and SMS messages (Figures 5P and 8A). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add e-mail, facsimile and SMS capabilities to **Mizikovsky's** invention for providing callers with response messages as taught by **Jambhekar's** invention in order not to distract a user by sending pre-programmed responses.

11. Claims 3-5,28,32,36,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Bremer** (US 6,018,671).

As to Claim 3, **Mizikovsky** teaches a method in accordance with Claim 1, wherein in response to an incoming call,

**Mizikovsky** does not teach the following limitation:

“the portable terminal alarms and waits during a certain delay, and if a user during said delay does not answer said call, the portable terminal sends said reply”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). **Bremer** teaches the limitation (Figure 4, labels 416,420). Having the

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cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add default capability to **Mizikovsky's** invention for providing callers with default messages as taught by **Bremer's** invention in order not to keep a caller waiting.

As to Claims 4,28,32,36,40, **Mizikovsky** teaches a method in accordance with claim 1, wherein in response to an incoming call, the portable terminal alarms, and:

**Mizikovsky** does not teach the following limitation:

“if a user gives a certain key command, the portable terminal sends said reply”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). **Bremer** teaches the limitation (Figure 4, labels 416,418). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add selected message capability to **Mizikovsky's** invention for providing callers with selected messages as taught by **Bremer's** invention in order not to keep a caller waiting.

As to Claim 5, **Mizikovsky** teaches a method in accordance with claim 3, wherein the portable terminal gives a mute soundless alarm (Col. 6, lines 43-50).

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Villa-Real** (US 4,481,382).

As to Claim 14, **Mizikovsky** teaches a method in accordance with claim 7:



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**Mizikovsky** does not teach the following limitation:

“wherein a reminder to call the identified calling party will be stored into the portable terminal, in order to be presented to a user later”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing selected accessory responses to callers (Figure 5, label 518). **Villa-Real** teaches reminder messages (Col. 1, lines 50-63). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add reminder capability to **Mizikovsky**'s invention for alerting users as taught by **Villa-Real**'s invention in order to provide reminders to users when calls become due.

13. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Wolff et al.** (US 5,327,486).

As to Claims 15-17, **Mizikovsky** teaches a method in accordance claim 1, wherein said reply includes:

**Mizikovsky** does not teach the following limitation:

“time information”

However, it is obvious that **Mizikovsky** suggests the limitation. This is because **Mizikovsky** teaches providing callers with selected user accessory responses (Figure 5, label 518). **Wolff** teaches the limitation (Figures 8-9). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add time capability to

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**Mizikovsky's** invention for providing callers with selected time-based messages as taught by  
**Wolff's** invention in order not to keep a caller waiting.

***Response to Arguments***

14. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Dufour et al.** (US 6,212,377) teach a radio telephone system which supports mobile telephones which can receive and transmit different messages.

**Sawyer et al.** (US 5,946,629) teach a mobile phone which can compose and send different message types.

16. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 306-0377 (for customer service assistance)


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**Allan Hoosain**  
**Primary Examiner**  
**10/2/03**